

REMARKS

A. Status of the Claims

Claims 1-25 43-46, 48-124 are pending in the present application.

Claims 43-46, 48-51 and 54-59 were cancelled notwithstanding Applicants' belief that the cancelled claims would have been allowable, without acquiescing to any of the Examiner's arguments, and without waiving the right to prosecute the cancelled (or similar) claims in another application, but rather for the purpose of furthering Applicants' business goals and expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG).¹

B. Allowed Claims

Applicants note, with appreciation, that the Examiner found Claims 1-25, 52, 53 and 86-124 were allowed.² In particular, the prior Office Action stated that "Claims 1-25 are free of the art."³

C. Objected-to Claims

The Examiner objected to Claims 60-72 under 37 CFR § 1.75 as allegedly being a substantial duplicate of claims 73-85 in that the claims "are so close in content that they both cover the same thing."⁴ Applicants respectfully disagree.

The Examiner's attention is respectfully drawn to Claims 60-72's recitation in step a) ii) of an isolated polypeptide "comprising a katanin p60 subunit." This is in contrast to Claim 73-85's recitation of an isolated "katanin p60 subunit" in step a) ii). While there is overlap in the scope of Claims 60-72 and Claims 73-85, the use of the open term "comprising" in Claims 60-72 and the absence of this term from Claims 73-85 mean that Claims 60-72 cover **different embodiments** from Claims 73-85. Therefore, Claims 60-72 are not substantial

¹ 65 Fed. Reg. 54603 (September 8, 2000).

² Paper No. 24, page 1, item 5.

³ Paper No. 16, page 13, item 22.

⁴ Paper No. 24, page 5, item 13.

duplicate of Claims 73-85. Accordingly, withdrawal of this objection is respectfully requested.

Claim 17 has been objected to for containing a period in the midst of text. However, Applicants' review did not find a period in the midst Claim 17's text. Nonetheless, if the Examiner's copy shows a period as a result of photocopying error, the Examiner is respectfully requested to change it by Examiner's amendment to place Claim 17 in condition for allowance.

D. Withdrawn Objections and Rejections

Applicants note, with appreciation, that the Examiner withdrew the following objections and rejections:⁵

1. Objection to the Specification;
2. Objection to Claims 17, 21, 25, 55, 58, and 59;
3. Rejection of Claims 2, 4, 9-12 and 55-59 under 35 U.S.C. §112, second paragraph, for alleged indefiniteness;
4. Rejection of Claims 43-46 and 49-54 under 35 U.S.C. §102(b) as being allegedly anticipated by McNally & Vale;
5. Provisional rejection of Claims 43-51 and 55-59 for obviousness-type double patenting over claims 43-71 of copending Application No. 09/724,595 (our docket No. UCSD-04868);
6. Provisional rejection of Claims 43-51 and 55-59 for obviousness-type double patenting over claims 51 and 55-66 of copending Application No. 09/724,602 (our docket No. UCSD-04869);
7. Provisional rejection of Claims 11-16 for obviousness-type double patenting over claims 11-16 of copending Application No. 09/724,887 (our docket No. UCSD-04865);
8. Provisional rejection of Claims 43-59 under 35 U.S.C. § 101 as claiming the same invention as claims 43-59 of copending Application No. 09/724,596 (our docket No. UCSD-04867); and

⁵ Paper No. 24, page 2-5, items 4-12.

9. Provisional rejection of Claims 1-10 under 35 U.S.C. § 101 as claiming the same invention as claims 1-10 of copending Application No. 09/724,887 (our docket No. UCSD-04865).

E. Objection to the Drawings

The drawings filed on April 7, 2003 were objected to under 35 U.S.C. § 132 for allegedly containing new matter.⁶ Applicants respectfully disagree.

The Examiner stated that "There is no support for the change from G to H at position 89 in Figure 1A or changing the last three Gs in Figure 1B..." This statement is incorrect. First, Applicants note that the formal drawing of Figure 1B that was mailed to the Office on April 3, 2003 did not change the "last three Gs in Figure 1B" as stated by the Examiner. Rather, only one "F" at amino acid position 223 was changed to a 'G.' Second, support for the corrected Figures 1A and 1B that were mailed to the Office on April 3, 2003 is indeed found in the priority provisional application serial no. 60/081,734 (our docket UCSD-04729) which shows an "H" at amino acid position 89 of Figure 1A (Tab 1) and a "G" at amino acid position 223 of the NSF protein in Figure 1B (Tab 1). In view of the support in the priority application, Applicants respectfully request withdrawal of the objection based on alleged new matter.

F. Maintained Rejections

The Examiner maintained the following rejections:

1. Claims 43-46 and 48-51 remain rejected under 35 U.S.C. §103(a) for alleged obviousness over McNally & Vale in view of Bonne *et al.*;⁷
2. Claims 43-46, 48-51 and 55-58 stand rejected under 35 U.S.C. §103(a) for being allegedly obvious over McNally & Vale in view of Bonne et al. and Balch (U.S. Patent No. 6,083,763);⁸ and

⁶ Paper No. 24, page 5, item 15.

⁷ Paper No. 26, page 6, item 16.

⁸ Paper No. 7, item 17.

3. Claims 43-46, 48-51 and 55-59 stand rejected under 35 U.S.C. §103(a) for being allegedly obvious over McNally & Vale in view of Bonne et al.⁹

Each of these rejections is moot in view of the cancellation of Claims 43-46, 48-51 and 54-59.¹⁰

CONCLUSION

All grounds of rejection and objection of the final Office Action of December 3, 2003 having been addressed, reconsideration of the application is respectfully requested. To expedite

⁹ Paper No. 26, page 8, item 18.

¹⁰ The claims were cancelled notwithstanding Applicants' belief that the unamended claims should have been allowable, without acquiescing to any of the Examiner's arguments, and without waiving the right to prosecute the cancelled (or similar) claims in another application, but rather for the purpose of furthering Applicants' business goals and expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG).

PATENTAttorney Docket No. **UCSD-04765**

prosecution, Applicants encourage the Examiner to call the undersigned at (415) 904-6500, before beginning to draft another written communication, if any.

Dated: January 13, 2004Mahattandan

Maha A. Hamdan

Registration No. 43,655

MEDLEN & CARROLL, LLP

101 Howard Street, Suite 350

San Francisco, California 94105

(415) 904-6500